

## **REMARKS**

The October 19, 2007 Official Communication (“the Notice”) indicates that Applicant’s response to the Requirement for Information mailed March 1, 2007 is incomplete. Specifically the Notice indicates Applicant’s previous response did not adequately address the requests for information under 37 C.F.R. § 1.105 on the following points:

**Point 1:** “Existing systems have the capability to query a network element such as an ONU or HDT for the version of software running on a particular card on a particular machine” (page 3, line 21 to page 4, line 1).

**Point 2:** “These ONU's are connected to corresponding multiplexors, which may be referred to as host digital terminals ("HDT's"). HDT's may be located, for example, in remote terminals (RT's) that are connected through routers located in central offices (CO's). Generally, the ONU's and HDT's comprise firmware cards therein” (page 2, lines 17-23).

**Point 3:** Each paragraph of the background section (pages 1-4) of the instant application.

**Point 4:** Identification of the other entities mentioned in the background section of Applicant disclosure by answering the following questions: are these entities different from the inventive entity of the instant application; and do these entities produce systems as described in the background section of the instant application. The Office specifically identified the following sections of Applicant’s disclosure.

- a. Marconi Communications Inc. (page 2, line 14)
- b. Service providers (page 3, line 11)
- c. Existing systems (page 3, line 21)

Applicant submits that the previous response complied fully with the requirements for the request for information under 37 C.F.R. § 1.105. Nevertheless,

in the interest of advancing prosecution, Applicant herein provides further answers to each of the Office's requests for information.

### **Requirements of Requests for Information**

37 C.F.R. §1.105 states, in relevant part, that:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application ... the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search: Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.
- (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

...

- (3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

### **Telephonic Communication with Examiner**

Applicant's representative, Benjamin Keim, contacted Examiner Wood by telephone on December 4, 2007. The Examiner indicated particular interest in answers to "point 4" above. Applicant understood the Examiner to specifically express interest in identifying "specific providers" and "existing systems" beyond those disclosed in this Application and supporting documents.

### **Inquiry Made**

In preparing the instant Response, Applicant's present attorney contacted the inventors of the subject application and the attorney who drafted the subject application ("the drafting attorney") and asked them each of the questions in the Request for Information. The inventors' and attorney's responses are summarized below.

### **Statement of the Inventors**

#### **Point 1:**

- (i) The inventors do not know of any particularly relevant commercial databases and/or information on any such commercial databases is not readily available to the inventors.
- (ii) The inventors did not perform a search of the prior art.

(iii) The “existing systems” refers to the resident capabilities within the Marconi system. There may have been other similar query-and-reply communication systems which operated between a host application and remote units in the field controlled by the host. However, the inventors did not know, at the time of invention or at the time of application for a patent, of any specific “[e]xisting systems [that] have the capability to query a network element such as an ONU or HDT for the version of software running on a particular card on a particular machine” other than the BellSouth/Marconi system.

(iv) The inventors did not draft the application and are not aware of any particular documents used to draft the noted portions of the application.

(v) The documents Marconi Manual, “Disk\*S FiberStar Element Management System,” Job Aids, 363-257-252, Issue 2, May 2000 and “Disk\*S FITL Ethernet Data Maintenance and Trouble Clearing,” TIL-010, Marconi Proprietary Information, Issue A, undated Beta Document (both submitted in the IDS filed November 12, 2002) were used in the invention process.

(vi) Generally, this invention is an improvement on “a technician ... manually check[ing] each ONU card and each multiplexor card for the software thereon, and if the software is not that which is desired, manually updat[ing] the software,” as disclosed in the instant application on page 4, lines 6-9.

(vii) The inventors do not know of any use of the claimed invention at the time the application was filed and/or identification of any such use is not readily available to the inventors.

**Point 2:**

- (i) The inventors do not know of any particularly relevant commercial databases and/or information on any such commercial databases is not readily available to the inventors.
- (ii) The inventors did not perform a search of the prior art.
- (iii) The inventors developed the invention disclosed in this application based on BellSouth systems leveraging firmware provided by Marconi. The inventors were not aware at the time of invention or at the time of application for a patent of any other related information pertaining to “[t]hese ONU's multiplexors, which may be referred to as host digital terminals ("HDT's"). HDT's may be located, for example, in remote terminals (RT's) that are connected through routers located in central offices (CO's). Generally, the ONU's and HDT's comprise firmware cards therein.”
- (iv) The inventors did not draft the application and are not aware of any particular documents used to draft the noted portions of the application.
- (v) The documents Marconi Manual, “Disk\*S FiberStar Element Management System,” Job Aids, 363-257-252, Issue 2, May 2000 and “Disk\*S FITL Ethernet Data Maintenance and Trouble Clearing,” TIL-010, Marconi Proprietary Information, Issue A, undated Beta Document (both submitted in the IDS filed November 12, 2002) were used in the invention process.
- (vi) Generally, this invention is an improvement on “a technician ... manually check[ing] each ONU card and each multiplexor card for the software thereon, and if the software is not that which is desired, manually

updat[ing] the software,” as disclosed in the instant application on page 4, lines 6-9.

(vii) The inventors do not know of any use of the claimed invention at the time the application was filed and/or identification of any such use is not readily available to the inventors.

**Point 3:**

Beyond the information already provided in this paper, Applicant’s previous response to the requests for information, and information disclosure statement, any additional information is unknown and/or not readily available to the inventors.

**Point 4:** Parts (a), (b), and (c).

(i) The inventors do not know of any particularly relevant commercial databases and/or information on any such commercial databases is not readily available to the inventors.

(ii) The inventors did not perform a search of the prior art.

(iii) The inventors state that Marconi Communications Inc. was not a part of BellSouth Telecommunications at the time of the invention and “service providers” does not refer to any specific company. “Service providers” was used as a general term to reference those entities that provide data transfer services infrastructure such as BellSouth. Marconi developed the optical network and controlling applications on which BellSouth delivered its service. Marconi is a different entity from the inventive entity of the instant application.

(iv) The inventors did not draft the application and are not aware of any particular documents used to draft the noted portions of the application.

(v) The inventors indicated that the only information used in the invention process, outside of their general knowledge as engineers and experience in this technical area, were Marconi documents and their experience using Marconi firmware to upgrade the ONUs. The documents Marconi Manual, “Disk\*S FiberStar Element Management System,” Job Aids, 363-257-252, Issue 2, May 2000 and “Disk\*S FITL Ethernet Data Maintenance and Trouble Clearing,” TIL-010, Marconi Proprietary Information, Issue A, undated Beta Document (both submitted in the IDS filed November 12, 2002) were used in the invention process.

(vi) Generally, this invention is an improvement on “a technician ... manually check[ing] each ONU card and each multiplexor card for the software thereon, and if the software is not that which is desired, manually updat[ing] the software,” as disclosed in the instant application on page 4, lines 6-9.

(vii) The inventors do not know of any use of the claimed invention at the time the application was filed and/or identification of any such use is not readily available to the inventors.

### **Statement of the Drafting Attorney**

#### **Point 1:**

In response to types of information identified in 37 C.F.R. § 1.105 (a)(1)(i)-(vii), such information is unknown and/or is not readily available.

**Point 2:**

In response to types of information identified in 37 C.F.R. § 1.105 (a)(1)(i)-(vii), such information is unknown and/or is not readily available.

**Point 3:**

In response to types of information identified in 37 C.F.R. § 1.105 (a)(1)(i)-(vii), the drafting attorney indicates that he did not retain any records associated with this application, nor did he use any information to draft the application beyond information supplied by the inventors. All relevant information supplied by the inventors is believed by the Applicant to be included in previously filed IDSs. Any other information that may have been used to draft this application is unknown and/or is not readily available to any individual identified under §1.56(c) or the assignee.

**Point 4:**

In response to types of information identified in 37 C.F.R. § 1.105 (a)(1)(i)-(iii), (v), and (vii), such information is unknown and/or is not readily available.

In response to types of information identified in 37 C.F.R. § 1.105 (a)(1)(iv) and (vi), language in the background of the specification referring to “[t]hese ONU’s,” “[s]ervice providers,” and “[e]xisting systems,” was intended to refer to the general state of the art at the time of filing of the instant application and was not based on any specific ONUs, service providers, and/or systems known to the drafting attorney other than those already cited in an IDS.



## CONCLUSION

Applicant believes that any information required to be submitted—beyond that already submitted in IDSs, the specification of the instant application, and prior responses to Office Communications—is unknown and/or is not readily available to any individual identified under §1.56(c) or the assignee.

Applicant respectfully submits that the reply filed on August 1, 2007, in conjunction with this paper, is a fully responsive amendment. Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1, 2, 4-9, 11-16 and 20, and favorable action on the subject application. If any issue remains unresolved that would prevent consideration of the reply filed on August 1, 2007, or allowance of this case, the Office is requested to contact the undersigned attorney to resolve the issue before issuing a subsequent Action.

Respectfully Submitted,

Dated: December 19, 2007

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